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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POINVIL, FRANTZY

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/774,682	Applicant(s) ASANO ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 9-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4 and 9-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed 12/18/2007 have been fully considered but they are not persuasive.
2. The Examiner's response is incorporated in the rejection found below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 9-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonaka et al. (GB 2,303,956) (hereinafter Nonaka) in view of Kamimura et al and/or PASA JAPAN KK and Templeton et al (US Patent No. 5,679,938).

Nonaka teaches a system and method for enabling a user of an IC card 1 to access an electronic purse 2 to make payment of a purchased item. Funds data are recorded in the electronic purse 2 and in a storage 34 located in a data center 3 (see at least the abstract, Figures 1-13, and pages 1-53, but in particular the locations cited below):. . In so doing, Nonaka discloses:

An electronic-money settlement method comprising the steps of:

recording, in a management center, information on a deposited amount of money, said information being stored in the form of electronic money representing a monetary value; and
recording, in said management center, information on a loan made to the user of the portable electronic device or IC card up to a predetermined limit (Figure 2a and 2b and 5 and 10 show the format of the data storage in the electronic purse 2). Loan information is also stored in personal information storage 34 of the management center 3.

Specifically, Nonaka states:

“If the user selects having loan on the electronic purse input unit 22, in the step S122, the charge is added to the sales storage 33 in the center 3 in a step S123, the sum of the loan is stored in the loan storage 61 shown in Fig. 2 and the loaned date is stored in the loaned date storage 62 shown in Fig. 2 respectively in the personal information storage 34 in a step S124. In this case, the total charge is processed as the sum of the loan.”.

Nonaka states that sum information storage 14 of the IC card 1 stores available card balance which the IC card user may use. Specifically, Nonaka states “The balance stored in the sum information storage 14 of the IC card 1 is read by the card reader/writer 84 and is compared with the charge of this service by the processor 85 in a step S415...”. See page 30, line 14 to page 31, line 6. Thus, the IC card of Nonaka clearly includes a processor 12 and a storage 14 for holding or storing information related to available funds in the IC card 1.

The applicant agrees that Nonaka teaches an electronic purse loan system wherein loan data is stored in a personal storage 34 in a data center 3 and cites Nonaka at page 19, line 23 to page 20, line 5, thus meeting applicant's claimed limitation of "recording in the management center, information on a loan made to a user of a portable electronic device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in the portable electronic device. The applicant argues that the same information is not stored in the portable device as required in their independent claim 1.

The only difference between the claimed invention and the teachings of Nonaka as argued by the applicant is that Nonaka fails to teach or suggest information on a loan is recorded in the IC card.

Kamimura et al and PASA JAPAN both disclose a system and method for providing a loan to a client using a portable IC card. The loan information is recorded in the IC card. See the references.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kamimura et al or PASU JAPAN KK in the system of Nonaka in order to allow storage of loan information in the IC card thereby providing instant loan data to a customer whenever desired.

Nonaka teaches several conditions for recording information in the electronic purse and in the management center. See also pages 12-13 of Nonaka. Recording information at the management center based on conditions such as "when a payment amount exceeds the remaining amount of the electronic money stored in said portable

electronic device” is only one of a multitude of possible conditions that would have been left to the users/owners described by Nonaka since such would not affect the functioning of the system of Nonaka and Kamimura et al and/or PASU JAPAN KK. Doing so would have enabled preferred usability of the system of Nonaka as all the claimed functionalities are enabled by the system of Nonaka.

As per the claimed limitation of “wherein said management center calculates interest on the loan at a predetermined frequency and uses the calculation result to update the information on the loan”, the applicant argues that such a feature is not present in Nonaka.

In response, whether or not Nonaka states calculating interest on a loan, the applicant’s representative argument that Nonaka fails to disclose, teach or suggest a management center that calculates interest on a loan is not convincing because Nonaka clearly teaches a management center providing a loan to a customer and recording the loan data at both the management center and the electronic purser. See page 1, first paragraph, page 14, third paragraph and page 20 of Nonaka. It noted that loans are usually provided wherein the loan provider’s intention is to charge interest on the loan amount so that a profit is made because of the risk involving in borrowing the loan amount and also because of administrative costs/functions. Thus, charging interest on the loan amount would have been obvious to one of ordinary skill in the art to do in the combined system noted above. Furthermore, Nonaka discloses storing all information regarding loan data and financial data on both the remote computer of management center and the electronic purse 2. Kamimura et al and/or PASU JAPAN KK teach

recording loan information on an IC card. Thus storing the interest data on both the management center and the portable device would have been obvious to do in Nonaka when modified by Kamimura or PASU JAPAN KK so as to always make a borrower's information always available to that particular borrower..

Regarding the newly added limitations of:

“determining if an identification code for a portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device; “,

The combination of Nonaka, Kamimura et al and/or PASA JAPAN does not explicitly recite such a limitation. However, such a limitation would have been obvious to one of ordinary skill in the art at the time the invention was made so that the central computer or data management center is aware of which accounts or files are delinquent or outstanding. Moreover, Templeton et al disclose a system and method for authorizing a transaction involving the payment of a check issued by a customer. In so doing, Templeton et al disclose maintaining a history or record of their customers, a negative file containing delinquent customers or accounts related to bad check data of the related customer and a positive file containing good check data of related customers. See column 13, lines 35-67 and column 12, lines 51-65 of Templeton et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Templeton et al into the combination of Nonaka,

Kamimura et al and/or PASA JAPAN in order to classify negative accounts from positive accounts so as to enable or disable a user's portable electronic device thereby alerting a holder of an electronic device to make the appropriate payment so that the portable electronic device can be enabled.

As per claim 3, an electronic-money settlement method according to claim 1, determining when the loan exceeds a predetermined limit is illustrated in figure 4, element S211 of Nonaka. Nonaka teaches determining upper limit of a customer's loan. Nonaka states "If the user's loan exceeds the upper limit in the step S311, a message showing his/her loan exceeds the upper limit is displayed on the display 21 of the electronic purse terminal 2 in the step S314 and his/her IC card is ejected from the electronic purse terminal 2 by the card controller 23 in the step S319". The management center prohibiting the use of the electronic money by the portable electronic device (S211) would have been obvious to one of ordinary skill in the art to do because the user would have exceeded the user's limit and the user's allowable funds had been exhausted thus preventing further debts to be owed by the user.

As per claim 4, an electronic-money settlement method according to claim 1, wherein said management center updates a record of the remaining amount of the electronic money stored in said portable electronic device when being instructed to store electronic money in said portable electronic device, and updates the remaining amount of the electronic money stored in said portable electronic device is taught and

discussed throughout Nonaka. Doing so, when being accessed by said portable electronic device so that priority is given to liquidation of the loan is not explicitly taught by Nonaka as modified above. Doing so would have enabled preferred usability of the system of Nonaka and Kamimura et al and/or PASU JAPAN KK as all the claimed functionalities are enabled by the system of Nonaka. Doing so, when being accessed by said portable electronic device so that priority is given to liquidation of the loan (S226) would have been obvious to do in the system of Nonaka and Kamimura et al and/or PASU JAPAN KK in order to reduce the debts of the owners of the system of Nonaka.

As per claims 9 and 17, Nonaka discloses an electronic money settlement method comprising the steps of:

loading electronic money from a portable electronic device into an information processing apparatus, said electronic money having a monetary value;

establishing a loan when a payment amount exceeds said monetary value of said electronic money, said payment amount being a purchase price of a commodity. As per these limitations, applicant is directed to page 13, first paragraph, page 14, third paragraph and page 20, lines 1-5 of Nonaka..

Nonaka does not explicitly state recording said loan in said portable electronic device.

Kamimura et al and PASA JAPAN KK both disclose a system and method for providing a loan to a client using a portable IC card. The loan information is recorded in the IC card. See the references.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kamimura et al or PASU JAPAN KK in the system of Nonaka in order to allow storage of loan information in the IC card thereby providing instant loan data to a customer whenever desired.

Regarding the newly added limitations of:

“determining if an identification code for a portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device; “,

The combination of Nonaka, Kamimura et al and/or PASA JAPAN does not explicitly recite such a limitation. However, such a limitation would have been obvious to one of ordinary skill in the art at the time the invention was made so that the central computer or data management center is aware of which accounts or files are delinquent or outstanding. Moreover, Templeton et al disclose a system and method for authorizing a transaction involving the payment of a check issued by a customer. In so doing, Templeton et al disclose maintaining a history or record of their customers, a negative file containing delinquent customers or accounts related to bad check data of the related customer and a positive file containing good check data of related customers. See column 13, lines 35-67 and column 12, lines 51-65 of Templeton et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Templeton et al into the combination of Nonaka, Kamimura et al and/or PASA JAPAN in order to classify negative accounts from positive

accounts so as to enable or disable a user's portable electronic device thereby alerting a holder of an electronic device to make the appropriate payment so that the portable electronic device can be enabled.

As per claims 10 and 20, see page 20, lines 1—5 and page 26, first paragraph and page 25, last paragraph of Nonaka.

As per claims 11-13, 19, 21, see page 17, second paragraph to page 18, first paragraph of Nonaka.

As per claims 14 and 23, it is noted that each time a payment or a purchase is made, such a transaction is recorded and therefore this limitation is interpreted as a history of use of the portable electronic device.

As per claims 15 and 22, Nonaka discloses prohibiting the use of the electronic money by the portable electronic device when the loan exceeds a predetermined limit. See page 25, lines 1-6 and page 26, third paragraph of Nonaka.

As per claim 16, inducing power into the portable electronic device is inherent in the portable device of Nonaka in order for the device to function.

As per newly added claims 24-38, these claims recite well known and/or obvious functions that would have been performed by a data card center or card issuers or service card providers. If the loan amount in a portable device exceeds a predetermined limit, then disabling the portable device, recording such in a negative file and prohibiting usage of the portable device would have been obvious to one of

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ordinary skill in the art to do in order to force the customer to bring their account to a satisfactory limit or positive status or to make the appropriate payment. Once such is done then allowing usage of the card, changing the status of the portable device and enabling usage of the portable device would have been obvious to one of ordinary skill in the art as such is an obvious measure of doing business in order to prevent abuse and to prevent issuers from further losses because of nonpayment by the holder of the portable devices.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/
Primary Examiner
Art Unit 3692**

FP
March 13, 2008

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